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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,397	12/27/2005	Kouju Okazaki	1155-0284PUS1	9717

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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REDDY, KARUNA P

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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04/24/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/540,397	<b>Applicant(s)</b> OKAZAKI ET AL.	
	<b>Examiner</b> KARUNA P. REDDY	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 8-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :6/23/2005, 9/23/2005, 7/31/2006.

### DETAILED ACTION

1. Preliminary amendment filed on 6/23/2005 is made of record. Claims 1-23 are currently pending in the application.

### *Election/Restrictions*

2. Applicant's election without traverse of group I, drawn to claims 1-7, in the reply filed on 2/25/2008 is acknowledged. Claims 8-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected groups II and III, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2/25/2008.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kishida et al (US 4, 388, 345).

Kishida et al disclose a coating composition comprised of (a) a mixture of (i) at least one polyfunctional monomer having at least three acryloyloxy or methacryloyloxy groups, (ii) at least one mono- or bi-functional monomer having one or two polymerizable unsaturated groups; and (b) a photosensitizer (abstract).

The acryloyloxy or methacryloyloxy group-containing polyfunctional monomers include, for example, trimethylolpropane triacrylate, pentaerythritol trimethacrylate and others (column 3, lines 27-35). The polymerizable unsaturated group-containing mono- or bi-functional monomers (ii) may be any of the ordinary monomers which have a radical polymerization activity. It is preferable that the polymerizable unsaturated group or groups contained in these monomers are (meth)acryloyloxy groups because these groups exhibit a high polymerization activity under ultraviolet rays (column 4, lines 58-65). Examples of bi-functional monomers include ethylene glycol diacrylate (column 4, lines 67-68; column 5, lines 1). As the (meth)acryloyloxy group containing mono-functional monomers there can be mentioned N-hydroxymethyl methacrylamide, N- N-hydroxyethyl methacrylamide, N-hydroxypropyl methacrylamide, 2-hydroxyethyl acrylate etc. Of these mono-functional monomers, acrylates having hydroxyl group and/or ether linkage are preferable. Such acrylates include, for example, hydroxyethyl acrylate, ethoxyethyl acrylate, butoxyethyl acrylate and tetrahydrofurfuryl acrylate (column 5, lines 49-68; column 6, lines 1-7).

See example 4 wherein the coating composition comprises dipentaerythritol hexaacrylate, dipentaerythritol pentaacrylate, N-(hydroxymethyl)acrylamide and tetrahydrofurfuryl acrylate. Given that, the composition of Kishida et al comprises substantially similar copolymer as that of the present claims, copolymer of Kishida et al inherently possesses the antifouling property. Case law holds that a material and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Therefore, Kishida et al anticipate the present claims.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kishida et al (US 4, 388, 345).

The discussion with respect to Kishida et al in paragraph 4 above, is incorporated here by reference.

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Kishida et al is silent with respect to transparency value of the copolymer.

However, in light of the fact that prior art teaches / discloses essentially the same copolymer as that of the claimed, one of ordinary skill in the art would have a reasonable basis to believe that the copolymer of prior art exhibits essentially the same properties. Since PTO cannot conduct experiments, the burden of proof is shifted to the applicants to establish an unobviousness difference. See *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

Even if properties of the copolymer of instant claims and prior art examples are not the same, it would still have been obvious to one of ordinary skill in the art to make copolymer having the claimed properties because it appears that the references generically embrace the claimed copolymer and the person of ordinary skill in the art would have expected all embodiments of the reference to work. Applicants have not demonstrated that the differences, if any, between the claimed copolymer and the copolymer of prior art give rise to unexpected results.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARUNA P. REDDY whose telephone number is (571)272-6566.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karuna P Reddy/  
Examiner, Art Unit 1796

/David Wu/  
Supervisory Patent Examiner, Art Unit 1796